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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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04/17/2001

Harald Kaufmann

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25889

7590

06/26/2008

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EXAMINER

ZIMMERMAN, JOSHUA D

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/807,774	<b>Applicant(s)</b> KAUFMANN, HARALD	
	<b>Examiner</b> JOSHUA D. ZIMMERMAN	<b>Art Unit</b> 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 28-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. Claims 28-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 28-30, the term “the assembled reflection transfer” lacks antecedent basis. Appropriate correction is required.

2. Claims 28, 32 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 28, applicant claims that the reflection particles are added to the reflection ink before applying the reflection ink on the transfer adhesive or the intermediate ink layer, respectively.” However, it is not clear how one can apply the reflection ink on the transfer adhesive when the intermediate ink layer is present. For examination purposes, it is assumed that applicant neglected to remove the option of applying the reflection ink on the transfer adhesive when applicant amended to require the presence of the intermediate ink layer. Appropriate correction is required.

3. Claims 34-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 34-36, applicant claims that the steps of claims 28-30, respectively, proceed sequentially in the order in which they are presented. However,

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claims 28-30 each recite in the second step that a transfer adhesive of an *assembled* reflection transfer is applied on the base medium *before* the other steps are recited.

Therefore, it is not clear how one can apply a transfer adhesive of an assembled reflection transfer before the reflection transfer is assembled. As such, prior art could not be applied

### ***Claim Objections***

4. Claims 28-30 and 33 are objected to because of the following informalities:

Claims 28-30 appear to have the same typo in the first line:

“The process” should be “A process” since no process has been previously recited.

Claim 33 appears to have a typo in line 2:

“toa” should be “to a”

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 28-30, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berg (US 3172942) in view of Nellessen et al. (US 3420597).

Regarding claim 28, Berg teaches a “process for the manufacture of a reflection transfer that is not clear translucent (title) comprising the steps:

initially providing an adhesive-repellant base medium (item 19);

applying a transfer adhesive of the assembled reflection transfer on the base medium, wherein the transfer adhesive is at least one of heat-sensitive and pressure sensitive (item 18);

applying an intermediate ink layer onto a side of said transfer adhesive opposite said base medium (item 17);

applying a reflection ink layer (items 12 and 16) comprising a plurality of reflection particles (item 14),

wherein said intermediate ink layer is not clear translucent (column 7, lines 21-33).”

Berg fails to teach that the reflection ink layer is applied “directly onto said intermediate ink layer, wherein said reflection particles are added to the reflection ink before applying the reflection ink on the transfer adhesive or the intermediate ink layer respectively;

drying the transfer such that at least some of the reflection particles are raised above the reflection ink layer; and

forming the reflection transfer via a screen printing process.”

Nellessen et al. teach a method of applying a reflective ink to a substrate comprising reflective particles (title, figures) comprising:

including the reflection particles in an ink before applying to the substrate (column 3, lines 35-40);

screen printing the ink onto the substrate (column 5, lines 55-57); and  
drying the applied ink film in order to expose the particles (Figure 2).

The method employed by Nellessen et al. improves upon the multi-step process employed by Berg by reducing the number of steps involved (column 2, lines 30-40).

Therefore, at the time of the invention, it would have been obvious to one having ordinary skill in the art to modify the method of Berg by using the reflective ink application method of Nellessen et al. in order to reduce the number of steps involved in the manufacturing process.

Regarding claim 29, Berg teaches a “process for the manufacture of a reflection transfer that is not clear translucent (title) comprising the steps:

initially providing an adhesive-repellant base medium (item 19);  
applying onto the base medium” a transfer film (item 13) comprising a transfer adhesive (item 16) and reflection particles (item 14)

wherein the “adhesive is not clear translucent (column 7, lines 29-31).”

Berg fails to teach:

that the adhesive layer contains the reflection particles,  
drying the transfer such that at least some of the reflection particles are raised above the reflection ink layer; and

forming the reflection transfer via a screen printing process.”

Nellessen et al. teach a method of applying a reflective ink to a substrate comprising reflective particles (title, figures) comprising:

including the reflection particles in an adhesive before applying to the substrate (column 3, lines 35-40);

screen printing the ink onto the substrate (column 5, lines 55-57); and

drying the applied ink film in order to expose the particles (Figure 2).

The method employed by Nellessen et al. improves upon the multi-step process employed by Berg by reducing the number of steps involved (column 2, lines 30-40).

Therefore, at the time of the invention, it would have been obvious to one having ordinary skill in the art to modify the method of Berg by using the reflective ink application method of Nellessen et al. in order to reduce the number of steps involved in the manufacturing process.

Regarding claim 30, Berg teaches a “process for the manufacture of a reflection transfer that is not clear translucent (title) comprising the steps:

initially providing an adhesive-repellant base medium (item 19);

applying a transfer adhesive of the assembled reflection transfer on the base medium, wherein the transfer adhesive is at least one of heat-sensitive and pressure sensitive (item 18);

applying a reflection ink layer (items 12 and 16) comprising a plurality of reflection particles (item 14),

wherein said transfer adhesive is not translucent (column 7, lines 21-33).”

Berg fails to teach that the reflection ink layer is applied “directly onto said transfer adhesive, wherein said reflection particles are added to the reflection ink before applying the reflection ink on the transfer adhesive; and

drying the transfer such that at least some of the reflection particles are raised above the reflection ink layer.”

Nellessen et al. teach a method of applying a reflective ink to a substrate comprising reflective particles (title, figures) comprising:

including the reflection particles in an ink before applying to the substrate (column 3, lines 35-40); and

drying the applied ink film in order to expose the particles (Figure 2).

The method employed by Nellessen et al. improves upon the multi-step process employed by Berg by reducing the number of steps involved (column 2, lines 30-40).

Therefore, at the time of the invention, it would have been obvious to one having ordinary skill in the art to modify the method of Berg by using the reflective ink application method of Nellessen et al. in order to reduce the number of steps involved in the manufacturing process.

Regarding claims 32 and 33, Berg further teaches “applying said reflection transfer to a substrate using a transfer press (column 7, lines 13-17).”

6. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berg (US 3172942) in view of Nellessen et al. (US 3420597), as applied to claim 30 above, further in view of Applicant’s Admitted Prior Art (AAPA)



Regarding claim 31, Berg and Nellessen et al. teach all that is claimed but fail to further teach “applying said transfer adhesive via a screen print process.” However, AAPA teaches using a screen print process in order to achieve a transfer system that can be manufactured in a simple manner, at a reasonable cost and in large numbers (page 3, lines 9-28 of applicant’s specification). Therefore, at the time of the invention, it would have been obvious to one having ordinary skill in the art to use a screen print process in the modified method of Berg in order to achieve a transfer system that can be manufactured in a simple manner, at a reasonable cost, and in large numbers.

### ***Response to Arguments***

7. Applicant's arguments filed 03/21/08 have been fully considered but they are not persuasive.
8. Regarding applicant’s argument that item 19 of Berg is not a base medium, it is the position of the Office that the item 19 can be interpreted as a base medium since, as seen in the entire structure of Figure 1, depending on the perspective of the viewer, item 19 can be a base. Furthermore, since it is an adhesive-repellant layer, it performs the same functions as the base layer which applicant is trying to claim.
9. In response to applicant's argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., the transfer layer not having to be turned upside down) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification,

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limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

10. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA D. ZIMMERMAN whose telephone number is (571)272-2749. The examiner can normally be reached on M-R 8:30A - 6:00P, Alternate Fridays 8:30A-5:00P.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on 571-272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joshua D Zimmerman  
Examiner  
Art Unit 2854

jdz

*/Leslie J. Evanisko/*  
Primary Examiner, Art Unit 2854